Mailed: January 23, 2004
Paper No. 16
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Pucci Corporation

Serial No. 76048785

Tamara A. Miller of Leydig, Voit & Mayer for Pucci Corporation.

Scott M. Oslick, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Hohein, Walters and Chapman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Pucci Corporation has filed an application to register the mark PUCCI on the Principal Register.[1] The originally-filed application identified the goods as follows:[2]

[1] Serial No. 76048785, in International Class 25, filed May 15, 2000, based on use, alleging use as early as September 3, 1928, and use in commerce as early as October 5, 1928. A refusal to register the mark on the ground that PUCCI is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. 1052(e)(4), was withdrawn after applicant submitted a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. 1052(f).

> Custom tailored apparel, namely, men's suits, tuxedo suits, topcoats, sport coats, sport trousers and sport shirts, and women's suits, skirts, topcoats and sport coats, and neckwear and accessories therefor, namely silk cravats, scarfs *(sic)*, mufflers, sweaters, socks and handkerchiefs.

Subsequent to applicant's filing of this appeal and the submission of applicant's and the Examining Attorney's briefs, applicant requested and was granted a remand to amend its identification of goods. The amendment, which follows, was accepted by the Examining Attorney:

> Custom tailored apparel, namely, men's suits, tuxedo suits, topcoats, sport coats, sport trousers and sport shirts, and neckwear and accessories therefor, namely silk cravats, scarves, mufflers, sweaters, socks and handkerchiefs.

The Examining Attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles

---

[2] At the Examining Attorney's request, applicant added to its application a claim of ownership of Registration No. 716,896 for the mark shown below for "Tailored apparel, namely, men's suits, tuxedo suits, topcoats, sport coats, sport trousers and sport shirts, and women's suits, skirts, topcoats and sport coats, and neckwear and accessories therefore, namely, silk cravats, scarves, mufflers, sweaters, socks and handkerchiefs." The registration includes a statement that the words CANDIDA PRAECORDIA PUCCI translate into English as "frankness of heart."

the mark EMILIO PUCCI,[3] previously registered for "children's clothing, namely, lounge robes, blouses, shirts, pants, dresses, and jackets"[4] and "ladies tailored apparel, namely, dresses, scarves, lingerie, hats, bathing suits, skirts, blouses, and slacks,"[5] that, when used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.[6]

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d

[3] The cited registrations contain the statement "Emilio Pucci identifies a living individual whose consent is of record."

[4] Registration No. 1,675,914, issued February 18, 1992, to Emilio Pucci S.R.L., in International Class 25. The registration has been renewed. Items deleted by registrant from the identification of goods in the registration are not listed.

[5] Registration No. 1,687,909, issued May 19, 1992, to Emilio Pucci S.R.L., in International Class 25. The registration has been renewed. Items deleted by registrantfrom the identification of goods in the registration are not listed.

[6] The final refusal also included Registration No. 1,690,242, which issued June 2, 1992, to Emilio Pucci S.R.L. for a stylized version of the mark EMILIO PUCCI for "ladies' tailored apparel, namely, dresses, scarves, lingerie, hats, bathing suits, skirts, blouses, slacks and footwear," in International Class 25. However, the registration has expired and, thus, the refusal is considered moot with respect to this registration.

1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Applicant contends that, while the PUCCI mark may call to mind the EMILIO PUCCI mark, the marks are sufficiently different to avoid confusion; and that the goods are quite distinct. Regarding the goods, applicant contends that its clothing is custom tailored and sold only at its Chicago establishment or by appointment in customers' homes;[7] that registrant's clothing is sold "off-the-rack" at retail outlets; that both applicant's and registrant's goods are expensive and sold to sophisticated consumers who exercise a high degree of care; and that applicant and registrant have coexisted for more than 50 years with no actual confusion.

Applicant submitted copies of two district court decisions from an infringement action involving applicant

[7] In this regard, applicant submitted copies of articles about its products.

(Pucci Corp.) and the cited registrant (Emilio Pucci S.R.L.). The action pertained to the marks herein as used in connection with perfume. In *Emilio Pucci S.R.L. v. Pucci Corp.*, 2 USPQ2d 1958 (N.D. Ill. 1987), the court found three of Pucci Corp.'s four counterclaim counts were barred by laches. Subsequently, at 10 USPQ2d 1541 (1988), the same court granted partial summary judgment to Emilio Pucci S.R.L., finding that Pucci Corp.'s remaining counterclaim count was barred by laches; that Emilio Pucci's registered mark is valid and a likelihood of confusion exists between the parties' marks for perfume; and, thus, that Pucci Corp.'s mark infringes Emilio Pucci's mark. The court required Pucci Corp. "to display the name 'Lawrence' prior to the name 'Pucci' with the same style print and size of letters in connection with the advertising and sale of its perfume anywhere outside of the Chicago metropolitan area," 10 USPQ2d at 1545, and to "include a disclaimer which states that its product is 'not associated or related to Emilio Pucci,'" 10 USPQ2d at 1546.

Applicant states in the case before us that its counterclaim counts in the district court proceeding pertained to the parties' use of their respective marks on clothing, and that the "implication" of the court's action in finding the counterclaim to be barred by laches was "because the parties' marks had coexisted for too long a

period to warrant any objection [and that] [n]o evidence of actual confusion between the parties' marks for clothing was presented, which presumably led the court to believe that the coexistence of the parties' marks could continue without causing actual confusion among consumers." (Brief, p. 12.) Applicant concludes that, in view of the coexistence of the marks for clothing, applicant is entitled to a registration without a likelihood of consumer confusion.

The Examining Attorney argues that the district court case involving applicant and the cited registrant is either not relevant or, contrary to applicant's contention, supports a conclusion that confusion is likely. In particular, he states that, while the marks in the district court action brought by the cited registrant against applicant are the same as those herein, the cited registrant's claims of infringement concerned perfume, whereas clothing was the issue in applicant's counterclaim counts, which were barred due to laches. He states, further, that, with respect to perfume, the district court required applicant to add the given name "Lawrence" to its mark PUCCI to avoid confusion.

With respect to the case before us, the Examining Attorney contends that the marks are substantially similar because both contain the surname PUCCI; that it is common in

the fashion industry for designers to use only a surname;[8] and that "prospective customers are likely to believe that the PUCCI goods are an additional line of apparel from the source of the EMILIO PUCCI goods." (Brief, p. 5.) The Examining Attorney contends that the goods are closely related "because various articles of clothing are commonly marketed and sold by the same party under the same mark." (Brief, p. 8.) In support of his position, the Examining Attorney submitted copies of third-party registrations showing, in each instance, the same or similar items of men's and women's clothing being identified by a single mark. He notes that applicant's argument that the goods are distinct because applicant is an exclusive clothier whose products may be purchased only through appointment in applicant's Chicago establishment or at customers' homes is not relevant because applicant's identification of goods is not so limited.

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are

[8] This statement is a conclusion that is not supported by any evidence in the record and, thus, is unpersuasive.

sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co*., 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Applicant's mark is the surname PUCCI and the registered mark consists of the identical surname PUCCI preceded by the given name EMILIO. There is no corresponding, but different, given name in applicant's mark to distinguish it from the registered mark. We find it likely that either the surname portion of a mark will be remembered more clearly by prospective purchasers than the given name portion thereof or that prospective purchasers will view applicant's mark as merely a short-hand version of the registered mark. Thus, we find these marks to be substantially similar and, if used in connection with the

same, similar or related clothing products, they are likely to be perceived by prospective purchasers as identifying product lines emanating from the same source.

Turning to consider the goods involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). *See also, Octocom Systems, Inc. v. Houston Computer Services, Inc.,* 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each

parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

Applicant amended its identification of goods to delete the previously listed items of women's clothing, thereby limiting its identified goods to specified men's clothing and accessories. Thus, applicant's identification no longer lists goods that are identical to those listed in the cited Registration No. 1,687,909 for the mark EMILIO PUCCI. The question remains, though, whether applicant's identified goods are related or similar to those in the cited registrations for, respectively, specified items of children's and women's clothing.

The record includes ten third-party registrations, based on use, for marks wherein a single mark identifies men's, women's and children's clothing items, many of which are the same or similar to the items involved herein. Although third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, are not evidence that the marks shown therein are in use or that the public is familiar with them, such registrations nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d

1467 (TTAB 1988). While there is no per se rule that clothing items are all related, we find the evidence of third-party registrations warrants the conclusion that applicant's goods are sufficiently related and/or similar to those in the two cited registrations that, if identified by confusingly similar marks, confusion would be likely.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, PUCCI, and registrant's mark, EMILIO PUCCI, their contemporaneous use on the same and otherwise closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

We are not convinced otherwise by applicant's arguments to the contrary. We agree with the Examining Attorney that applicant's arguments about differing channels of trade are unavailing because none of the involved identifications of goods are limited. Similarly, the involved products are broadly identified and, thus, encompass inexpensive everyday clothing items purchased by all consumers as well as expensive custom clothing. Finally, we also do not infer any conclusion of no likelihood of confusion from the district court decision involving applicant and the cited registrant, nor do we find the district court decisions involving different products and the issue of infringement to be relevant to the registrability issue before us.

Decision: The refusal to register under Section 2(d) of the Act is affirmed with respect to Registration Nos. 1,675,914 and 1,687,909.